REMARKS/ARGUMENTS

Claims 1-139 remain pending herein. Claims 1-17 and 45-139 have been withdrawn from consideration by the U.S. PTO.

Claim 36 is amended as set forth above to address an objection to claim 36. It is respectfully requested that the U.S. PTO reconsider and withdrawn this objection.

Claims 18-44 were rejected under 35 U.S.C. §112, second paragraph. The Office Action contains statements that the expressions "derivatives of said compounds", "metabolites of said compounds", "analogues of said compounds", and "mimic molecules" are vague and indefinite.

In addition, the Office Action contains a statement that the expressions "precursor molecules of circiliol", "derivatives of circiliol", "metabolites of circiliol", "analogues of circiliol", and "mimic molecules" in claim 19 are vague are indefinite.

The Office Action also includes a statement that the expression "substantially simultaneously" in claim 26 is vague.

Claims must be construed from the standpoint of a person skilled in the relevant art in determining whether they particularly point out the subject matter which is covered by the claim. It is respectfully noted that persons of skill in the art would be able to discern whether any particular compound falls inside or outside the scope of each of these expressions.

Patentable inventions cannot always be described in terms of exact measurements, symbols and formulae, and the applicant necessarily must use the "meager tools provided by language, tools which admittedly lack exactitude and precision. If the claims, read in the light of the specification, reasonably apprise

those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more.

In addition, it is respectfully noted that the term "substantially" has been consistently held to be definite (see, e.g., Ex parte Wheeler, 163 USPQ 569 (USPTO Board of Appeals 1968)), and therefore the expression "substantially simultaneously" is not indefinite.

It is respectfully requested that the U.S. PTO reconsider and withdraw this rejection.

Claims 18-44 were rejected under 35 U.S.C. §112, first paragraph. The Office Action includes a statement that the specification is enabling for the treatment of lung cancer and pancreatic cancer, but does not reasonably provide enablement for the treatment of neoplasia in general. In addition, claims 18-21 and 23-44 were rejected under 35 U.S.C. §112, first paragraph. The Office Action includes a statement that the specification is enabling for the use of gemcitabine as the chemotherapeutic agent, but does not reasonably provide enablement for chemotherapeutic agents in general.

Claims 18-44 are directed to methods of treating a patient suffering from neoplasia, comprising administering to the patient at least one chemotherapeutic agent and at least one compound selected from the group of compounds recited in claim 18. The present specification discloses that the advantage of such a method is that the chemotherapeutic agent can be administered in much lower doses than normally administered. Persons of skill in the art are familiar with chemotherapeutic agents which can be used to treat many different types of neoplasias, and the

specification indicates that such agents can be used in accordance with these known treatments, but with lower dosages when used according to the methods according to the present invention. In addition, the present specification provides a description of *in vitro* testing which demonstrated that lower dosages of chemotherapeutic agent can be employed when used according to the methods according to the present invention.

A rejection for lack of enablement can only be made if there is reason to doubt the objective truth of the statements that the invention would be useful as disclosed in the specification. Whenever a rejection on this basis is made, it is incumbent upon the U.S. PTO to provide reason *why* the truth or accuracy of a statement in a supporting disclosure would be doubted by those of skill in the art, and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

The present invention is not directed to discovery of new chemotherapeutic agents or to the discovery that known chemotherapeutic agents can be used to treat neoplasias against which such chemotherapeutic agents had not been known to be effective. Rather, the present invention is directed to using known chemotherapeutic agents to treat neoplasias against which such agents are known to be effective, and also administering at least one of the compounds recited in claim 18 in order to be able to reduce the dosage of the chemotherapeutic agents. The *in vitro* data reported in the specification confirms the statements in the specification that the compounds reicted in claim 18 indeed make it possible to reduce the dosage of chemotherapeutic agent, and nothing in the record refutes such statements.

It is respectfully requested that the U.S. PTO reconsider and withdraw this rejection.

Claims 18-27, 30-33 and 37-44 were rejected under 35 U.S.C. §103(a) over WO 00/03706 (WO '706) in view of WO 99/01118 (WO '118), further in view of Tsukada et al., "Biochemical and Biophysical Research Communications" (Tsukada et al.).

The Office Action contains an assertion that in formula I of WO '706, when R_1 and R_5 are H, R_4 is OH, and R_6 is a phenyl group substituted with two OH groups, the resulting compound is circiliol. It is respectfully noted that in addition, it would be necessary that R_2 and R_3 be methoxy groups. WO '706 discloses for each of the substituents R_1 - R_6, a number of possible choices, whereby the number of possible combinations of substituents R_1 and R_6 is extremely large, and yet WO '706 contains no suggestion which would lead a person of skill in the art to make the specific selections which would be necessary in order to arrive at circiliol from within the large number of compounds encompassed by the disclosure in WO '706.

The Office Action contains a statement that WO '118 discloses a method to enhance the cytotoxic activity of an antineoplastic drug comprising administering an effective amount of an antineoplastic drug to a host in combination with an effective amount of an antioxidant. A large group of antioxidants are disclosed in pages 25-43 of WO '118, among which are inhibitors of lipoxygenases, but WO '118 does not contain disclosure which would guide a person of skill in the art to make specific selections so as to arrive at circiliol from within the very large number of antioxidants encompassed by the disclosure in WO '118.

The Office Action contains a statement that Tsukada et al. discloses that circiliol is an arachidonate 5-lipoxygenase inhibitor.

It has been repeatedly and consistently held that disclosure of subject matter which broadly encompasses a claimed invention does not, absent guidance which would cause one of skill in the art to arrive at specifically claimed subject matter does not anticipate such claimed subject matter, and does not render obvious such subject matter where the subject matter achieves unexpectedly favorable properties. In the present situation, the present specification demonstrates that the claimed invention achieves results which provide favorable properties which would not have been expected in view of the applied references, and which provides such favorable properties to an extent which would not have been expected in view of the applied references. Accordingly, it is respectfully submitted that the claimed invention is patentable over the applied references, and accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Claim 28 was rejected under 35 U.S.C. §103(a) over WO '706 in view of WO '118 and Tsukada et al., further in view of U.S. Patent No. 6,608,026 (Wang '026).

Wang '026 is cited for alleged disclosure of administration of radiation treatment. Any such disclosure in Wang '026 would not overcome the shortcomings of the references applied against claim 18, from which claim 28 depends.

It is respectfully requested that the U.S. PTO reconsider and withdraw this rejection.

Claims 29 and 34-36 were rejected under 35 U.S.C. §103(a) over WO '706 in view of WO '118 and Tsukada et al., further in view of U.S. Patent No. 6,569,853 (Borisy '853).

Borisy '853 is cited for alleged disclosure of performing surgery and of tablets which may be coated.

It is respectfully requested that the U.S. PTO reconsider and withdraw this rejection.

In view of the above, claims 18-44 are in condition for allowance.

If the Examiner believes that contact with Applicant's attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call Applicant's attorney at the phone number noted below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

October 11, 2005
Date

Kevin C. Brown
Reg. No. 32,402

KCB/jms

BURR & BROWN
P.O. Box 7068
Syracuse, NY 13261-7068

Customer No.: 025191
Telephone: (315) 233-8300
Facsimile: (315) 233-8320